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In re Application of	:
Peter Von Matt et al	:
Serial No.: 10/542,175	: PETITION DECISION
Filed: July 14, 2005	:
Attorney Docket No.: TX/4-32732A	:

This is in response to the petition under 37 CFR 1.144, filed February 16, 2007, requesting withdrawal of an improper Lack of Unity requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 371 and was accepted on July 14, 2005, and contained claims 1-10, as amended. In a first Office action mailed August 1, 2006, the examiner set forth a Lack of Unity requirement, as follows:

- Groups I-VI, claims 1-5 and 7-9 drawn to compounds represented by specific structures (see restriction requirement for specifics);
- Group VII, claim 6 drawn to a method of preparation of the compounds;
- Group VIII, claim 10 drawn to methods of use of the compounds.

The examiner stated that the structure of Formula I was known and did not form a special technical feature and Unity was therefore lacking. The examiner also indicated that the listing of structures represented in the first six groups was not exhaustive and applicants could identify and elect any other species or group.

Applicants replied on October 18, 2006, electing, with traverse, the compound of Example I from the specification which did not appear to be encompassed within any of the Groups set forth. Applicants argued that the Lack of Unity set forth did not follow the guidelines set forth in the PCT Rules.

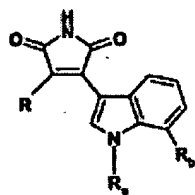
In the next Office action mailed to applicants on December 20, 2006, the examiner maintained the Lack of Unity requirement for the reasons set forth and made the requirement Final. The examiner then defined the scope of applicants' claims by defining the variables' values. Claim

10 was rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. Claims 1-10 were rejected under 35 U.S.C. 103(a) as unpatentable over Albert et al.

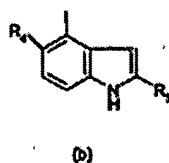
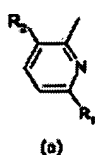
Applicants filed this petition of the restriction requirement on February 16, 2007.

DISCUSSION

Applicants basically reiterate the same arguments made in the first traversal of the Lack of Unity, specifically that Groups I-VI should be grouped together as they all have the same special technical feature and common activity. A review of the claims shows that all compounds are based on Formula I, as shown here:



The examiner found that the above structure absent the R groups was known in the art and could not be considered a special technical feature. However R could be one of two groups, as follows:



Based on combining either (a) or (b) with Formula I the examiner created six structures with different values for the various other R groups on which Lack of Unity was based. Applicants have traversed this division, but not the separation of the method of making and method of using groups. Applicants urge that all compounds should be grouped together based on Formula I as it is the significant structural element possessed by all compounds and provides the activity thereof.

In order for Unity to be present in a grouping of compounds designated as a Markush group, the compounds must possess a common property or activity (as here) and must possess a significant structural element shared by all, or belong to a recognized class of chemical compounds. By significant structural element is meant a structure or structural portion which occupies a large portion of the structure and is structurally distinctive. Here Formula I occupies a large portion of the structure, but is not distinctive since it is known as evidenced by prior art cited by the examiner. However structures where (a) or (b) are combined with Formula I are larger structures which form two distinct significant structural elements which may each possess Unity of Invention with compounds having the same structural element.

Applicants' request for withdrawal of the Lack of Unity requirement is granted to the extent that compounds of Formula I combined with (a) form one Group and compounds of Formula I combined with (b) form a second Group. It is noted that the examiner has, in accordance with PCT guidelines included in the examination the method of making and method of using claims. The requirement is redrafted as follows:

Group I – claims 1-10, drawn to compounds and corresponding methods of Formula I with R being structure (a); and

Group II – claims 1-10, drawn to compounds and corresponding methods of Formula I with R being structure (b).

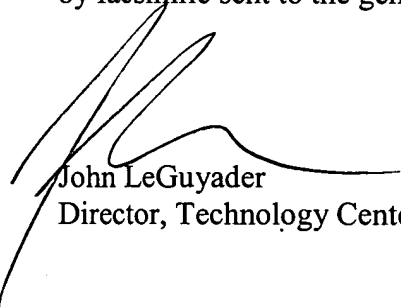
As applicants have elected a compound which falls within one of these groups, that group is constructively elected and applicants may respond to the Office action accordingly.

DECISION

The petition is **GRANTED-IN-PART.**

Applicants remain under obligation to reply to the Office action mailed December 20, 2006, within the time period set therein or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader
Director, Technology Center 1600